REMARKS

Claims 1-16 have been examined on their merits, and are all the claims presently pending in the application.

Applicants herein amend claims 1 and 7 to clarify that the compound destination address does not include intermediate routing addresses.

Applicants herein editorially amend claims 4, 8 and 10. The amendments to claims 4, 8 and 10 were made for reasons of precision of language and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 4, 8 and 10 were not made for reasons of patentability.

1.   Claims 1-10 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Boivie (U.S. Patent No. 6,502,140). Applicants traverse the rejection of claims 1-10 for at least the reasons discussed below.

To support a conclusion that a claimed invention lacks novelty under 35 U.S.C. § 102, a single source must teach all of the elements of a claim. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). A single source must disclose all of the claimed elements arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). Rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior

art. Thus, the cited reference must clearly and unequivocally disclose every element and limitation of the claimed invention.

With respect to claim 1, Boivie does not teach or suggest a device that adds a suffix list to a common prefix to create a compound destination address that consists of compressed final destination addresses. Instead, Boivie illustrates a compressed address that necessarily includes intermediate routing addresses along with destination addresses. For example, at col. 4, line 55, Boivie discloses a compound address "R1 (B R2 (C D))" that includes intermediate routing addresses R1 and R2 along with the destination addresses. *See, e.g.,* Figure 1 of Boivie. Boivie does not teach or suggest that the compound address does not include the intermediate routing addresses. Critically, Boivie invention relies upon one of the "fundamental tenets of Internet 'philosophy'" is that complexity should be concentrated at the edges of the network, and thus, the disclosure of Boivie relies upon the intermediate routing addresses being present within the compound address in order for the data packets to arrive at their respective destinations. In contrast, the present invention excludes intermediate routing addresses from being included in a compound destination address.

Based on the foregoing reasons, Applicants submit that Boivie fails to disclose all of the claimed elements as arranged in claim 1. Therefore, under *Hybritech* and *Richardson*, Boivie clearly cannot anticipate the present invention as recited in independent claim 1. Thus, Applicants submit that claim 1 is allowable, and further submit that claims 2-6 and 8-10 are allowable as well, at least by virtue of their dependency from claim 1. Applicants respectfully request that the Examiner withdraw the § 102(e) rejection of claims 1-6 and 8-10.

With respect to claim 7, Boivie does not teach or suggest a method that adds a suffix list to a common prefix to create a compound destination address that consists of compressed final destination addresses. The compound address "R1 (B R2 (C D))" at col. 4, line 55 of Boivie includes intermediate routing addresses R1 and R2 along with the destination addresses. *See*, *e.g.*, Figure 1 of Boivie. Unlike the present invention, Boivie does not teach or suggest an addressing method wherein the compound address excludes intermediate routing addresses.

Based on the foregoing reasons, Applicants submit that Boivie fails to disclose all of the claimed elements as arranged in claim 7. Therefore, under *Hybritech* and *Richardson*, Boivie clearly cannot anticipate the present invention as recited in independent claim 7. Thus, Applicants submit that claim 7 is allowable, and respectfully request that the Examiner withdraw the § 102(e) rejection of claim 7.

2. Claims 11-16 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Boivie. Applicants traverse the rejection of claims 11-16 for at least the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837

F.2d 1071, 1074 (Fed. Cir. 1988).

b) The proposed modification of the prior art must have had a reasonable expectation of

success, and that determined from the vantage point of the artisan at the time the

invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed.

Cir. 1991).

c) The prior art reference or combination of references must teach or suggest all the

limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In*

re Wilson, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior

art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In*

re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit

from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on

an express or an implicit showing of motivation, the USPTO is obligated to provide particular

findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad

conclusionary statement, standing alone without support, is not "evidence." *Id.; see also, In re*

Zurko, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual

components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather,

particular findings must be made as to the reason the skilled artisan, with no knowledge of the

claimed invention, would have selected these components for combination in the manner

claimed. *Id.*

Boivie does not teach or suggest a device that adds a suffix list to a common prefix to create a compound destination address that consists of compressed final destination addresses, as recited in claim 1 and included in claims 11-13 by virtue of their dependency from claim 1. As discussed above with respect to claim 1, Boivie does not teach or suggest a device that adds a suffix list to a common prefix to create a compound destination address that consists of compressed final destination addresses. The compound address "R1 (B R2 (C D))" at col. 4, line 55 of Boivie includes intermediate routing addresses R1 and R2 along with the destination addresses. *See, e.g.*, Figure 1 of Boivie. Unlike the present invention, Boivie does not teach or suggest an address compression device wherein the generated compound address excludes intermediate routing addresses. Thus, Applicants submit that the Examiner cannot fulfill the "all limitations" prong of a *prima facie* case of obviousness, as required by *In re Vaeck.*

Since Boivie fails to disclose the exclusion of intermediate routing addresses in a compound address, Applicants submit that one of skill in the art would not be motivated to modify Boivie. Although the Examiner provides a motivation analysis with respect to adapting differently sized prefixes, Boivie lacks any teaching about the desirability of a compound address that excludes intermediate routing addresses. Applicants submit that the Examiner cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko.*

Based on the foregoing reasons, Applicants submit that Boivie fails to disclose all of the claimed elements as arranged in claim 1, and included via dependency in claims 11-13.

Therefore, Boivie clearly cannot render the present invention obvious as recited in claims 11-13.

Thus, Applicants submit that claims 11-13 are allowable, and respectfully request that the

Examiner withdraw the § 103(a) rejection of claims 11-13.

Boivie does not teach or suggest as addressing method that adds a suffix list to a common

prefix to create a compound destination address that consists of compressed final destination

addresses, as recited in claim 7 and included in claims 14-16 by virtue of their dependency from

claim 7. As discussed above with respect to claim 7, Boivie does not teach or suggest an

addressing method that adds a suffix list to a common prefix to create a compound destination

address that consists of compressed final destination addresses. The compound address "R1 (B

R2 (C D))" at col. 4, line 55 of Boivie includes intermediate routing addresses R1 and R2 along

with the destination addresses. *See, e.g.*, Figure 1 of Boivie. Unlike the present invention,

Boivie does not teach or suggest an addressing method wherein the generated compound address

excludes intermediate routing addresses. Thus, Applicants submit that the Examiner cannot

fulfill the "all limitations" prong of a *prima facie* case of obviousness, as required by *In re*

Vaeck.

Since Boivie fails to disclose the exclusion of intermediate routing addresses in a

compound address, Applicants submit that one of skill in the art would not be motivated to

modify Boivie. Although the Examiner provides a motivation analysis with respect to adapting

differently sized prefixes, Boivie lacks any teaching about the desirability of a compound address

that excludes intermediate routing addresses. Applicants submit that the Examiner cannot fulfill

the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Based on the foregoing reasons, Applicants submit that Boivie fails to disclose all of the claimed elements as arranged in claim 7, and included via dependency in claims 14-16. Therefore, Boivie clearly cannot render the present invention obvious as recited in claims 14-16. Thus, Applicants submit that claims 14-16 are allowable, and respectfully request that the Examiner withdraw the § 103(a) rejection of claims 14-16.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,
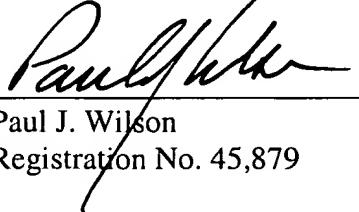
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